

Application No. 09/335,742
Attorney Docket No. 5725.0429-00

REMARKS

I. Status of the Claims

Claims 1-3, 5-9, 11-30, and 32-57 were pending in the application. Claims 28 and 29 have been allowed by the Examiner. Claim 57 is cancelled herein, without prejudice or disclaimer. Claims 1, 30, 33, 55, and 56 are amended herein. Thus, claims 1-3, 5-9, 11-30, and 32-56 remain for examination.

II. Rejections under 35 U.S.C. § 103

A. Henkel in view of Tsujino

Claims 1-3, 5-9, 11-27, 30, 32-34, and 37-56 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Henkel (WO 92/13824) in view of Tsujino (U.S. Patent No. 4,961,925). *Office Action* at pp. 2-4. Applicant respectfully traverses this rejection.

The Examiner continues to assert that it would have been obvious to add any of the claimed second oxidation bases to Henkel's exemplified compositions because Henkel teaches that conventional oxidation bases can be added. *Office Action* at p. 4. Tsujino is cited for disclosing oxidation bases that are conventional in the hair dyeing art. *Id.*

Although Applicants respectfully disagree, to expedite prosecution, claim 1 has been amended to incorporate the limitations of dependent claim 57, which recites at least one second oxidation base chosen from para-phenylenediamine, N,N-bis-(β -hydroxyethyl)-para-phenylenediamine, 2-(β -hydroxyethyl)-para-phenylenediamine, 4-aminophenol, and acid-addition salts thereof. Accordingly, claim 57 has been

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cancelled. Independent claims 30, 33, 55, and 56 have been amended in a similar manner to claim 1.

Applicants respectfully note that claim 57, which was newly added in the Amendment filed December 19, 2003, was not rejected in the Final Office Action, nor was its allowability indicated.

In two Declarations under 37 C.F.R. § 1.132, filed on April 15, 2003, and December 19, 2003, Applicant demonstrated unexpectedly good UV resistant properties for a composition comprising the first oxidation base 1,8-bis(2,5-diaminophenoxy)-3,6-dioxaoctane in conjunction with any one of the four second oxidation bases now recited in amended claims 1, 30, 33, 55, and 56. Thus, the two Declarations provided evidence of unexpected results, for at least these four second oxidation bases, over the combined teachings of Henkel and Tsujino.

Because the two Declarations show unexpected results for each one of the claimed second oxidation bases, this showing is commensurate with the scope of the claims. Moreover, one of ordinary skill in the art would readily expect that the acid addition salts would provide similarly superior results.

One of the basic requirements to establish a *prima facie* case of obviousness is a reasonable expectation of success. M.P.E.P. § 2143.02. Accordingly, "Applicant may present evidence showing there was no reasonable expectation of success." *Id.* Applicant respectfully submits that such a showing was made here. There would have been no reasonable expectation of success for one of ordinary skill that the selected oxidation bases claimed would produce unexpectedly good results over the other oxidation bases disclosed in Tsujino, and yet they have been shown to do so.

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In the Final Office Action, the Examiner noted that "compositions within the scope of examples 1-3 would be allowable," in referring to the Declaration filed April 15, 2004, showing unexpected results for para-phenylenediamine, N,N-bis-(β -hydroxyethyl)-para-phenylenediamine, and 2-(β -hydroxyethyl)-para-phenylenediamine. Although the Examiner did not comment on the second Declaration, filed on December 19, 2003 and showing unexpected results for 4-aminophenol, Applicants respectfully submit that for similar reasons, a claim to 4-aminophenol as a second oxidation base should also be allowable for the same reasons.

Accordingly, Applicant respectfully requests withdrawal of this rejection.

B. Andrillon in view of Henkel

Claims 1-3, 5-9, 11-13, 15-38, 41-53 and 55-56 are rejected under 35 U.S.C. § 103 over Andrillon (U.S. Patent No. 4,065,255) in view of Henkel (WO 92/13824). *Office Action* at pp. 4-7. Applicant respectfully traverses this rejection.

The Examiner continues to base the rejection on Andrillon, for teaching the use of a particular class of couplers, in view of Henkel, for teaching compositions comprising 1,8-bis(2,5-diaminophenoxy)-3,6-dioxaoctane. *Office Action* at pp. 5-7.

Although Applicant respectfully disagrees, to expedite prosecution, claims 1, 30, 33, 55, and 56 have been amended, as discussed above. Neither Andrillon nor Henkel teach or suggest combining 1,8-bis(2,5-diaminophenoxy)-3,6-dioxaoctane with the claimed second oxidation bases now recited in amended claims 1, 30, 33, 55, and 56. Moreover, as discussed above, the evidence of the two Declarations provide a showing of unexpected results over the combined teachings of Andrillon and Henkel.

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In view of the above, Applicant respectfully requests withdrawal of this rejection.

III. **Conclusion**

In view of the foregoing, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: August 6, 2004

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CERTIFICATE OF FACSIMILE UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence is being transmitted by facsimile to the United States Postal Services under 37 C.F.R. § 1.8 on the date indicated below and is addressed to Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

on August 6, 2004
Date

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